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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/722,141  | 11/26/2003  | Jeffrey M. Wendlandt | 6530.0272-01        | 2752             |
| 22852   | 7590        | 01/19/2005           | EXAMINER            |                  |
| FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER<br>LLP<br>901 NEW YORK AVENUE, NW<br>WASHINGTON, DC 20001-4413 |             |                      | HOANG, TU BA        |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3742                |                  |

DATE MAILED: 01/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                         |                  |
|------------------------------|-------------------------|------------------|
| <b>Office Action Summary</b> | Application No.         | Applicant(s)     |
|                              | 10/722,141              | WENDLANDT ET AL. |
|                              | Examiner<br>Tu Ba Hoang | Art Unit<br>3742 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on \_\_\_\_\_.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) 1 is/are rejected.  
 7) Claim(s) \_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 26 January 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

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This is a continuation of 09/768,337 with only one claim, i.e., claim 1 is pending and claims 2-44 have already been cancelled.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected under the judicially created doctrine of double patenting over claims 1 or 14 of U. S. Patent No. 6,736,773 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: "a head attached to a distal end of the extension arm wherein the head includes a vision member capable of receiving an image of a surgical site". Although the conflicting claims are not identical, they are not patentably distinct from each other because the recited "vision member" in the present application would be in either the inherency or in the equivalence of the recitation of the "vision chip" (in claim 1 of the patent) and claim 1 of the present application is clearly broader in scope than claim 14 of the patent by omitting "and wherein the vision member includes a vision chip.....external to the endoscope".

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See also MPEP § 804.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by De Faria-Correa et al (US 5,533,496). De Faria-Correa et al shows an endoscopic device

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(Figure 3A) comprising an endoscope body or cannula (27) having proximal and distal ends, an extension arm or elongated endoscope tube (30) passing through a channel (36) in the endoscope body (27) to the distal end of the endoscope body (27), a head (1) attached to a distal end of the extension arm or endoscope tube (30), wherein the head (1) includes a vision member which includes a viewing tip (31), a viewing window (2), and vision chips or lens (column 3, line 65) capable of receiving an image of a surgical site.

Claim 1 is further rejected under 35 U.S.C. 102(b) as being anticipated by Hassler (DE 29716512). Hassler shows an endoscopic device comprising an endoscope 2 having proximal and distal ends, an extension arm 4 passing through a channel in the endoscope to the distal end of the endoscope (as shown in Figure 2), a head attached to a distal end of the extension arm or cable 41, wherein the head includes a vision member or mirror 5 capable of receiving an image of a surgical site.

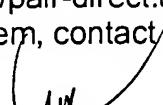
Claim 1 is also rejected under 35 U.S.C. 102(b) as being clearly anticipated by Thompson (US 5,762,603). Thompson shows an endoscopic device comprising an endoscope body 1 having proximal and distal ends, an extension arm 29 passing through a channel in the endoscope body to the distal end of the endoscope body, a head 5 attached to a distal end of the extension arm 29, wherein the head 5 includes a vision member or image sensor capable of receiving an image of a surgical site.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Miyazaki (US 6,184,923), Hori et al (US 5,582,576), De Faria-Correa et al (US 5,448,990), Knighton (US 5,373,840), Oku (US 5,215,077), Chiba (US 4,976,524), and Chikama (US 3,871,365).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tu Ba Hoang whose telephone number is (571) 272-4780. The examiner can normally be reached on Mon-fri from 8:30AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robin Evans can be reached on (571) 272-4777. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Tu Ba Hoang  
Primary Examiner  
Art Unit 3742

December 27, 2004